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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* TAKAAKI AMANO and YOSHIHARU MAEDA

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Appeal 2009-004307  
Application 09/863,877  
Technology Center 3600

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Decided: March 19, 2010

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Before HUBERT C. LORIN, DONALD E. ADAMS, and BIBHU R.  
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1 and 4-10 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

## SUMMARY OF THE DECISION

We REVERSE and enter a new grounds of rejection under 35 U.S.C. § 112, second paragraph.

## THE INVENTION

The Appellants' claimed invention is directed to an advertisement supplying system for displaying a "point" which may give viewing persons an incentive to view the advertisement in combination with advertisement information (Spec. 1:12-16). Claim 1, reproduced below with some numerals in bracketing added, is representative of the subject matter of appeal.

1. An advertisement supplying system for displaying a point which gives viewing persons an incentive to view an advertisement in combination with advertisement information on a terminal apparatus connected thereto via a computer network, comprising:
  - storage means for storing therein identification information of a customer and a point degree owned by the customer in relation to each other;
  - means for accepting the identification information of the customer from a terminal apparatus of the customer;
  - means for acquiring the point degree owned by the customer from said storage means, said owned point degree being related to the accepted identification information of the customer; and
  - display point degree determining means for determining a display point degree to be displayed in combination with the advertisement information based upon a relationship between the

point degree owned by the customer and the display point degree with reference to a predetermined rule; wherein

said rule being that a point degree owned by the customer increases in response to the customer selecting the advertisement and the display point degree decreases for display in combination with a subsequent display of the advertisement information, and

[1] the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement.

### THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Goldhaber

US 5,794,210

Aug. 11, 1998

The following rejections are before us for review:

1. Claim 4 is rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point and distinctly claim the subject matter which the Appellants regard as the invention.

2. Claims 1, 5 and 8-10 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement for the specification for failing to reasonably convey that the inventors had possession of the claimed invention and for lacking enablement.

3. Claims 1-4 and 10 are rejected under 35 U.S.C. § 102(b) as being anticipated by Goldhaber.

## THE ISSUE

At issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejections.

With regards to the rejection of claim 4 under 35 U.S.C. § 112, second paragraph, this issue turns on whether those skilled in the art would understand what is claimed when the claim is read in light of the specification.

With regards to the rejection of claims 1, 5, and 8-10 under 35 U.S.C. § 112, first paragraph this issue turns on whether: 1) the applicants show possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention, and 2) whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation.

With regard to the rejection of claims 1-4 and 10 under 35 U.S.C. § 102(b) this turns on whether Goldhaber discloses claim limitation [1].

## FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:<sup>1</sup>

FF1. The Specification describes Figure 12 as a diagram for explaining an image of point change rule as to a total gained-point number with respect to one banner advertisement (Spec. 6:8-10).

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<sup>1</sup> See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF2. The Specification at Fig. 12 discloses that the “display point number” decreases as the “gained point number” increases in a step-wise manner and does not decrease to zero initially.

FF3. The Specification at Fig. 12 shows that after 100 points are gained the display point number does decrease to zero.

FF4. Goldhaber discloses an attention brokerage (Title) which provides for payment to computer users for paying attention to an advertisement over a computer network such as the Internet (Abstract).

FF5. Goldhaber at Fig. 11 shows an example of a computer display and at Fig. 12 shows an example of the overall process performed by a consumer computer and attention broker server (Col. 9:21-25).

FF6. Goldhaber at Col. 17:33-63 discloses that if the consumer did everything correctly that the CyberCoin is inactivated to prevent the consumer from receiving additional compensation by repeating the process for the same ad.

FF7. Goldhaber at Col. 18:13-33 discloses that coupons may be displayed in addition to CyberCoins 62.

FF8. Goldhaber at Fig. 11, Fig. 12, Col. 17:33-63, and Col. 18:13-33 does not disclose both that a display point degree decreases for display in combination with a subsequent display of the advertisement information, and that the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting a advertisement.

FF9. The Specification at page 34 contains no algorithm to disclose “means for determining a display point degree to be displayed”.

## PRINCIPLES OF LAW

### *Principles of Law Related to 35 U.S.C. § 112, first paragraph*

#### *Written description*

The factual inquiry for determining whether a specification provides sufficient written description for the claimed invention is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

#### *Enablement*

The PTO bears the initial burden when rejecting claims for lack of enablement.

When rejecting a claim under the enablement requirement of section 112, the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement. If the PTO meets this burden, the burden then shifts to the applicant to provide suitable proofs indicating that the specification is indeed enabling.

*In re Wright*, 999 F.2d 1557, 1561-62 (Fed. Cir. 1993) (citing *In re Marzocchi*, 439 F.2d 220, 223-24 (CCPA 1971)).

It is by now well-established law that the test for compliance with the enablement requirement in the first paragraph of 35 U.S.C. § 112 is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). “Enablement is not precluded by the necessity for some experimentation... However, experimentation needed to practice the invention must not be undue experimentation. The key word is ‘undue,’ not ‘experimentation.’” *In re Wands*, 858 F.2d at 736-737.

To evaluate whether a disclosure would require undue experimentation, the Federal Circuit has adopted the following factors to be considered:

- (1) The quantity of experimentation needed to make or use the invention based on the content of the disclosure;
- (2) The amount of direction or guidance presented;
- (3) The existence of working examples;
- (4) The nature of the invention;
- (5) The state of the prior art;
- (6) The relative skill of those in the art;
- (7) The level of predictability in the art; and
- (8) The breadth of the claims.

*In re Wands*, 858 F.2d at 737. The examiner’s analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. *Id.*



*Principles of Law Related to 35 U.S.C. § 112, second paragraph*

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).

*Principles of Law Relating to Anticipation*

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim.

ANALYSIS

*Rejections under 35 U.S.C. § 112, first paragraph*

The Appellants argue that the rejection of claim 1 is improper because the Specification provides support for claim limitation [1] at 6:14-15, 35:16-37:5, and Fig. 12 (Br. 8-10).

In contrast the Examiner has determined that the claim is properly rejected under 35 U.S.C. § 112, first paragraph because does not provide support for the cited claim limitation [1] (Ans. 3-5).

We agree with the Appellants. Claim 1 includes the cited limitation [1] which requires:

“the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement”.

The Specification at Fig. 12 discloses that the “display point number” decreases as the “gained point number” increases in a step-wise manner and does not decrease to zero initially (FF2). As such, the applicants have shown possession of the claimed invention by describing the claimed invention with all of its cited limitations using descriptive means in words and figures that fully set forth the claimed invention.

The Examiner has also asserted that the claimed invention lacks enablement (Ans. 4-5) however the Examiner has failed to apply an analysis the factors required to show undue experimentation for enablement as cited in *In re Wands*, 858 F.2d at 737. As such, the Examiner has failed to set forth a reasonable explanation as to why it is believed that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application.

For these reasons the rejection of claim 1 under 35 U.S.C. § 112, first paragraph, is not sustained. Claims 5 and 8-10 have the same limitation as addressed above and the rejection of these claims is also not sustained for the same reasons given above.

*Rejections under 35 U.S.C. § 112, second paragraph*

The Appellants argue that the rejection of claim 4 is improper because claim 1 does not state that the point degree never decreases to zero (Br. 8).

The Examiner has determined that claim 4 is ambiguous because if the minimum number of points to be displayed for a first occurrence is zero,

then the system cannot prevent “the point degree from not decreasing to zero for the subsequent display of the (same) ad or advertisement” since it is already zero for the first occurrence of the ad (Ans. 10-11).

We agree with the Appellants. The Specification at Fig. 12 discloses that the “display point number” decreases as the “gained point number” increases in a step-wise manner and does not decrease to zero initially (FF2). The Specification at Fig. 12 also discloses that after 100 points are gained the display point number does decrease to zero (FF3). Thus, those skilled in the art would understand what is claimed when the claim is read in light of the specification because Fig. 12 shows that the number of points does not initially decrease to zero, but does decrease to zero if 100 gained point numbers are acquired. Thus, those skilled in the art would understand that what is being claimed in claim 4 is the display after 100 gained points are acquired.

For these reasons the rejection of claim 4 under 35 U.S.C. § 112, second paragraph, is not sustained.

*Rejections under 35 U.S.C. § 102(b)*

The Appellants argue that the rejection of claim 1 is improper because Goldhaber fails to disclose limitation [1] (Br. 10-11). The Examiner asserts that Goldhaber discloses such a feature at Figs. 11 and 12, Col. 17:33-63, and Col. 18:13-33 (Ans. 9). The Examiner has also asserted that the claim limitation [1] “is at best non-functional and non-descriptive material” (Ans. 12).

We agree with the Appellants. Claim 1 includes the cited limitation [1] which requires:

“the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement”.

This cited claim limitation is not non-functional descriptive material as asserted by the Examiner. The PTO need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Gulack*, 703 F.2d 1381, 1386 (Fed. Cir. 1983). *See also In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004); *In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994). The burden of establishing the absence of a novel, nonobvious functional relationship rests with the PTO. *In re Lowry*, 32 F.3d at 1584.

Goldhaber at Fig. 11, Fig. 12, Col. 17:33-63, and Col. 18:13-33 does not disclose both that a display point degree decreases for display in combination with a subsequent display of the advertisement information, and that the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting an advertisement (FF8). For these reasons the rejection of claims 1 and 4-10 under 35 U.S.C. § 102(b) is not sustained.

#### NEW GROUNDS OF REJECTION

Pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection of claims 1 and 5-7 under 35 U.S.C. § 112, second paragraph as being indefinite

*Principles of Law*

Means-plus-function claim language must be construed in accordance with 35 U.S.C. § 112, paragraph 6, by “look[ing] to the specification and interpret[ing] that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure.” *In re Donaldson Co.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc).

When no structure is described in the Specification to support a means-plus-function limitation in a claim, the disclosure is inadequate to explain to one of ordinary skill in the art what is meant by the claim language. In such a situation, a means-plus-function claim would not be amenable to construction and thus would fail to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.

"[I]f one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112." *In re Donaldson Co.*, 16 F.3d 1189, 1195 (Fed.Cir.1994) (en banc). .... This duty to link or associate structure to function is the *quid pro quo* for the convenience of employing § 112, ¶ 6. *See O.I. Corp. v. Tekmar Co.*, 115 F.3d 1576, 1583 (Fed. Cir. 1997). "Fulfillment of the § 112, ¶ 6 trade-off cannot be satisfied when there is a total omission of structure." *Atmel*, 198 F.3d at 1382. While corresponding structure need not include all things necessary to enable the claimed invention to work, it must include all structure that actually performs the recited function. *See Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1119 (Fed.Cir.2002).

*Default Proof Credit Card Sys. v. Home Depot U.S.A., Inc.*, 412 F.3d 1291, 1298 (Fed. Cir. 2005).

When the means-plus-function limitation in a claim is a *computer-enabled* means-plus-function limitation, one must set forth in the specification sufficient description of an *algorithm* associated with the function recited in the claim in order to avoid a finding that an applicant has failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.

It is certainly true that the sufficiency of the disclosure of algorithmic structure must be judged in light of what one of ordinary skill in the art would understand the disclosure to impart. *See, e.g., Intel Corp. v. VIA Techs.*, 319 F.3d 1357, 1367 (Fed. Cir. 2003) (knowledge of a person of ordinary skill in the art can be used to make clear how to implement a disclosed algorithm); *Atmel Corp.*, 198 F.3d at 1379 (“[T]he ‘one skilled in the art’ analysis should apply in determining whether sufficient structure has been disclosed to support a means-plus-function limitation.”). That principle, however, has no application here, because in this case there was no algorithm at all disclosed in the specification. The question thus is not whether the algorithm that was disclosed was described with sufficient specificity, but whether an algorithm was disclosed at all.

*Aristocrat Techs. Australia Party, Ltd. vs. Int’l Game Tech.*, 521 F.3d 1328, 1337 (Fed. Cir. 2008).

When there is insufficient description of an algorithm in the Specification to support a computer-enabled means-plus-function limitation in a claim, the disclosure will be considered inadequate to explain to one of ordinary skill in the art what is meant by the claim language.

For computer-implemented means-plus-function claims where the disclosed structure is a computer programmed to implement an algorithm, “the disclosed structure is not the general purpose

computer, but rather the special purpose computer programmed to perform the disclosed algorithm.” *WMS Gaming, Inc. v. Int’l Game Tech.*, 184 F.3d 1339, 1349 (Fed.Cir.1999). Thus the patent must disclose, at least to the satisfaction of one of ordinary skill in the art, enough of an algorithm to provide the necessary structure under § 112, ¶ 6. This court permits a patentee to express that algorithm in any understandable terms including as a mathematical formula, in prose, *see In re Freeman*, 573 F.2d 1237, 1245-46 (CCPA 1978), or as a flow chart, or in any other manner that provides sufficient structure. The district court correctly determined that the structure recited in the ‘505 specification does not even meet the minimal disclosure necessary to make the claims definite. Simply reciting “software” without providing some detail about the means to accomplish the function is not enough. *See Aristocrat Techs. Austl. Pty v. Int’l Game Tech.*, 521 F.3d 1328, (Fed.Cir.2008) (“For a patentee to claim a means for performing a particular function and then to disclose only a general purpose computer as the structure designed to perform that function amounts to pure functional claiming. Because general purpose computers can be programmed to perform very different tasks in very different ways, simply disclosing a computer as the structure designated to perform a particular function does not limit the scope of the claim to ‘the corresponding structure, material, or acts’ that perform the function, as required by section 112 paragraph 6.”). This court does not impose a lofty standard in its indefiniteness cases. *See, e.g., Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1214 (Fed.Cir.2003). But in this case, the claims are already quite vague. Without any corresponding structure, one of skill simply cannot perceive the bounds of the invention.

*Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1340-41 (Fed. Cir. 2008).

When a Specification discloses *no* algorithm corresponding to a computer-enabled means-plus-function limitation in a claim, an applicant has necessarily failed to particularly point out and distinctly claim the

invention as required by the second paragraph of section 112. *See also Aristocrat*, 521 F.3d 1328, 1333 (*quoting Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1253 (Fed. Cir. 2005) (“[t]he corresponding structure for a § 112 ¶ 6 claim for a computer-implemented function is the algorithm disclosed in the specification.” *Harris* 417 F.3d at 1249.”); *Net MoneyIN, Inc. v. Verisign, Inc.* 545 F.3d 1359, 1367 (Fed. Cir. 2008) (“[A] means-plus-function claim element for which the only disclosed structure is a general purpose computer is invalid if the specification fails to disclose an algorithm for performing the claimed function.”). *See also Blackboard, Inc. v. Desire2Learn Inc.*, 574 F.3d 1371 (Fed. Cir. 2009) (finding Blackboard’s means-plus-function claims indefinite because the patent describes an undefined component, *i.e.*, a black box, that performs the recited function but does not disclose how the component performs the function). *See further Ex parte Catlin*, 90 USPQ2d 1603, 1605 (BPAI 2009) (precedential) (during prosecution, computer-enabled means-plus-function claims will be held unpatentable under 35 U.S.C. § 112, second paragraph, as being indefinite if a Specification fails to disclose any algorithm corresponding to the recited function in the claims).

#### *Analysis*

We reject claims 1 and 5-7 under 35 U.S.C. § 112, second paragraph as being indefinite.

We will focus on the “means for determining a display point degree to be displayed” limitation. But the analysis to follow applies equally as well to the other means-plus-function limitations in claims 1 and 5.



The limitation “means for determining a display point degree to be displayed” includes the term “means.” A claim limitation that includes the term “means” is presumed to be intended to invoke means-plus-function treatment, *i.e.*, treatment under 35 U.S.C. § 112, 6<sup>th</sup> paragraph. *Rodime PLC v. Seagate Tech., Inc.*, 174 F.3d 1294, 1302 (Fed. Cir. 1999) (“presumed an applicant advisedly used the word “means” to invoke the statutory mandates for means-plus-function clauses.”).

Construing means-plus-function claim language in accordance with 35 U.S.C. § 112, paragraph 6, is a two step process.

The first step in construing a means-plus-function claim limitation is to define the particular function of the claim limitation. *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376 (Fed.Cir.2001). “The court must construe the function of a means-plus-function limitation to include the limitations contained in the claim language, and only those limitations.” *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1113 (Fed.Cir.2002). Thus, according to the language of claim 11, the function of the “horizontal drive means” is “rotating said lamp unit in a horizontal direction.” Ordinary principles of claim construction govern interpretation of this claim language, *see id.*, and, for all the reasons discussed in the preceding two sections, we construe this function according to its ordinary meaning as not requiring rotation through 360°.

The next step in construing a means-plus-function claim limitation is to look to the specification and identify the corresponding structure for that function. “Under this second step, ‘structure disclosed in the specification is “corresponding” structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.’” *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1210 (Fed.Cir.2003) (quoting *B. Braun Med. Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424 (Fed.Cir.1997)).

*Golight Inc. v. Wal-Mart Stores Inc.*, 355 F.3d 1327, 1333-34 (Fed. Cir. 2004).

*Step 1-* The first step in construing a means-plus-function claim limitation is to define the particular function in the means-plus-function limitation.

The particular function of the means-plus-function claim limitation at issue is “is for determining a display point degree to be displayed”.

Further, given the claim as a whole being directed to a “system for displaying a point...via a computer network” which we have construed as reasonably broadly involving a computer, one of ordinary skill in the art would construe the claim limitation “means for authenticating the buyer as the financial account” to refer to a *computer-enabled* means-plus-function limitation.

*Step 2-* The next step in construing a means-plus-function claim limitation is to look to the Specification and identify the corresponding structure for that function. Given that the claim limitation “means for determining a display point degree to be displayed” is a *computer-enabled* means-plus-function limitation, this requires looking to the Specification and identifying the algorithm corresponding to the function “for determining a display point degree to be displayed”.

In that regard, we note that in the Summary of Claimed Subject Matter (App. Br. 3-4), the Appellants have attempted to show where in the Specification, by page and line number, there is disclosed structure, material, or acts corresponding to each claimed function as required by 37 C.F.R. § 41.37(c)(1)(v) (2007). With regard to the claim determining a display point degree to be displayed means-plus-function limitation at issue, the

Appellants attempt to show that the disclosed structure is shown at page 34. We find no algorithm to disclose “means for determining a display point degree to be displayed” at page 34 (FF9).

The Specification therefore fails to disclose an algorithm corresponding to the recited function at issue (FF9) in claims 1 and 5-7 such that one of ordinary skill in the art could determine the scope of claims 1 and 5-7. Accordingly, we reject claims 1 and 5-7 under 35 U.S.C. § 112, second paragraph, as being indefinite.

#### CONCLUSIONS OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting claims 4 under 35 U.S.C. § 112, second paragraph, for failing to particularly point and distinctly claim the subject matter which the Appellants regard as the invention.

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1, 5 and 8-10 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement for the specification failing to reasonably convey that the inventors had possession of the claimed invention and for lacking enablement.

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1 and 4-10 under 35 U.S.C. § 102(b) as being anticipated by Goldhaber.

We enter a new grounds of rejection under 35 U.S.C. § 112, second paragraph for claims 1 and 5-7.

## DECISION

The Examiner's rejection of claims 1 and 4-10 is reversed.

We also enter a new ground of rejection of claims 1 and 5-7 under 35 U.S.C. § 112, second paragraph.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REVERSED; 37 C.F.R. § 41.50(b)

Appeal 2009-004307  
Application 09/863,877

MP

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